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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/764,774
Filing Date: January 26, 2004
Appellant(s): DE VROOME, CLEMENS JOHANNES

MAILED
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GROUP 1700

Attorney William C. Gehris
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/03/2006 appealing from the Office action mailed 5/01/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-------------|-------------|--------|
| 20020106444 | MENET ET AL | 8-2002 |
| 196 50 125 | GERMANY | 6-1998 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 7-8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over MENET ET AL in view of GERMAN 196 50 125 (hereinafter referred to as WERNER ET AL).

MENET ET AL teach a coating application system comprising a device for applying a liquid mixture of a silicone based material and at least water to a web or sheet material, the device having including a reservoir for the silicone based material (41; pg. 2, (0035)), a supply source for carrier fluid or water (30), at least one mixing tank (40) for the silicone oil concentrate and the water, an applicator (5) for transferring the liquid mixture onto a cooled roll for transfer to the web or sheet printing material, the applicator being a sprayer head enclosing and thereby containing the liquid mixture, and a cooling roll (1A, 1B) in communication with the web or sheet material (See Fig. 3). While MENET ET AL recognizes a coating supply arrangement wherein a buffer tank or even a crucible could be used in the system (pg.3, (00451)), MENET ET AL is silent concerning the supply management including a buffer tank in combination with the mixer wherein liquid coating material liquid from a supply reservoir is received in a buffer tank prior to introduction to the mixer. However, it was known in the coating art, at the time the invention was made, to provide in a coating supply arrangement, an intermediate or buffer tank in combination with a mixer whereby liquid coating material from a supply reservoir was supplied to the buffer tank prior to introduction to the mixer as evidenced by WERNER ET AL (see translation at page 2). In the citation, WERNER ET AL recognizes the benefit of an intermediate or buffer tank to store a smaller content of the liquid coating material in case of a process change. Therefore, it would have been

Art Unit: 1734

obvious to one of ordinary skill in the art to provide an intermediate or buffer tank as taught by WERNER ET AL in communication with the silicone based reservoir prior to the mixer in the system of MENET ET AL in order to temporarily store a smaller amount of liquid coating material in case of a process change. Additionally, MENET ET AL explicitly recognizes the supply arrangement to be used for adjusting the coating composition (pg. 3, (0049)) such that one of ordinary skill in the art would expect to provide an intermediate or buffer tank of smaller volume capacity in order to enable a small amount of the silicone material to be adjusted physically (i.e., heated via crucible) and/or chemically (i.e., such as pH adjustment). With respect to the use of fluid regulating means including valving, MENET ET AL provides for controlled fluid regulating means as evidenced by pg. 3, (0044). Moreover, WERNER ET AL recognizes controlled fluid regulating means or valving on pages 2-3 of the translation. With respect to the use of a small capacity (i.e., 1 liter) mixer, see MENET ET AL pg. 3, (0047). Alternatively, WERNER ET AL recognize the buffer or intermediate tank to have a capacity less than 200 liters (pg. 2 of translation). With respect to claim 15, the applicator of MENET ET AL can be read to comprise a two-part construction including the sprayer (5) in fluid communication with the roller (10) that directly applies the coating material to one surface of the web or sheet material while supported on its opposite side by a cooling roller.

(10) Response to Argument

In response to appellant's argument that MENET ET AL is nonanalogous art since it is not directed to supplying any mixture to a web-shaped printing material, it has

been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, MENET ET AL is applied to teach a coating application system comprising a device for applying a liquid mixture of a silicone based material and at least water to a web or sheet material, the device having including a reservoir for the silicone based material (41; pg. 2, (0035)), a supply source for carrier fluid or water (30), at least one mixing tank (40) for the silicone oil concentrate and the water, an applicator which includes sprayer (5) for transferring the liquid mixture onto a cooled roll for transfer to the web or sheet printing material, the sprayer head enclosing and thereby containing the liquid mixture, and a cooling roll (1A, 1B) in communication with the web or sheet material (See Fig. 3). MENET ET AL fails to teach a buffer tank in combination with the mixer wherein liquid coating material liquid from a supply reservoir is received in the buffer tank prior to introduction to the mixer. However, as discussed above, it would have been obvious to one of ordinary skill in the art to provide an intermediate or buffer tank as taught by WERNER ET AL in communication with the silicone based reservoir prior to the mixer in the system of MENET ET AL in order to temporarily store a smaller amount of liquid coating material in case of a process change. MENET ET AL coating application system as modified is capable of applying mixture to a web-shaped printing material since it teaches every structural element of the claimed apparatus. Note a recitation of the intended use of the claimed invention must result in a structural

difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *Ex parte Masham*, 2 USPQ2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it was known in the coating art, at the time the invention was made, to provide in a coating supply arrangement, an intermediate or buffer tank in combination with a mixer, a supply reservoir for a first liquid coating material and a supply source for a second liquid coating material whereby the first liquid coating material from the supply reservoir was supplied to the buffer tank prior to introduction to the mixer wherein the first and second liquid coating material was mixed as evidenced by WERNER ET AL (see translation at page 2). In the citation, WERNER ET AL recognizes the need to adjust the coating composition to be applied to the substrate within a coating system and teaches the benefit of using an intermediate or buffer tank to store a smaller content of the liquid

coating material to reduce costs associated with a change in the coating composition of the process. MENET ET AL also explicitly recognizes the need to adjust the coating composition within a coating system and teaches elements of the supply arrangement for the applicator are to be used for adjusting the coating composition (pg. 3, (0049 and 0045)). Therefore, it would have been obvious to one of ordinary skill in the art to provide an intermediate or buffer tank such as taught by WERNER ET AL in communication with the silicone based reservoir prior to the mixer in the system of MENET ET AL in order to temporarily store a smaller amount of liquid coating material in case of a process change especially in view that MENET ET AL explicitly recognizes the desirability of adjusting the coating composition in a process (pg. 3, (0049)) and one of ordinary skill in the art would have expected that the Werner et al intermediate or buffer tank of smaller volume capacity would enable one to change the amount of the silicone material in the liquid coating mixture in the MENET ET AL system. Note in the case of direct application of the liquid coating mixture to the substrate, the MENET ET AL cooling roll in the modified MENET ET AL cooling roll stand and coating process is the cooling roller arranged directly opposite from the roller on which the coating is applied by a respective one of the applicators.

Appellant's argument that MENET ET AL and WERNER ET AL each fail to teach the device includes a first supply line from the buffer tank to the mixing tank and a first valve in the supply line operated by a control unit and/or regulating unit so that a continuous, quasi-continuous or intermittent flow of the silicone is produced is found to be non-persuasive and a second supply line from the supply source to the mixing tank

Art Unit: 1734

and a second valve in a second supply line, line between the supply source and mixer, operated by a control unit and/or regulating unit so that a continuous, quasi-continuous or intermittent flow. MENET ET AL teaches providing a regulating means to regulate silicone feed (see paragraph 0044). Moreover, WERNER ET AL recognizes controlled fluid regulating means for the coating system which includes a first valve in a first supply line for feeding the first liquid coating material from the buffer tank to the mixing tank. Therefore, it would have been obvious given the modifications of the MENET ET AL as discussed above to provide a first supply line between the buffer tank and the mixer along with a first valve and regulating means for regulating the first valve since WERNER ET AL teaches doing so to control fluid flow within the coating system. Further, it would have been obvious given the modifications of the MENET ET AL coating system as discussed above to provide a second valve in the MENET ET AL second supply line 30, line between the supply source (obviously present to supply water to supply line 30) and mixer, operated by a control unit and/or regulating unit so that a continuous, quasi-continuous or intermittent flow for the advantage by WERNER ET AL of controlling liquid flow within a coating system which mixes separate coating components to form a mixture used in a coating system.

Appellant's argument that MENET ET AL and WERNER ET AL each fail to teach the mixing tank has a smaller volumetric capacity than the buffer tank and volumetric capacity of the mixing tank and buffer tank is within the scope of claims is found to be non-persuasive. With respect to the use of a small capacity (i.e., 1 liter) mixer, see MENET ET AL pg. 3, (paragraph 0047). Alternatively, WERNER ET AL recognizes the

Art Unit: 1734


volumetric capacity of the mixer is less than the volumetric capacity of the buffer or intermediate tank and volumetric capacity of the buffer or intermediate tank is less than 200 liters (pg. 2 of translation). Further, it would have been an obvious matter of design choice given the modifications of the MENET ET AL system as discussed to optimize provide the volumetric capacity of the buffer tank such that it is within the scope of the claim since such a modification would have involved a mere change in a size or dimension of a component and especially given WERNER ET AL recognition that the volumetric capacity of the mixer is less than the volumetric capacity of the buffer or intermediate tank and volumetric capacity of the buffer or intermediate tank is less than 200 liters . A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Brenda Adele Lamb

Conferees:

Art Unit: 1734

Chris Fiorilla



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